



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/571,466	08/25/2006	Thomas Rueckle	285616US0PCT	6605
22850	7590	04/29/2008	EXAMINER	
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			WEDDINGTON, KEVIN E	
		ART UNIT	PAPER NUMBER	
		1614		
		NOTIFICATION DATE		DELIVERY MODE
		04/29/2008		ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com
oblonpat@oblon.com
jgardner@oblon.com

Claims 11 and 14-25 are presented for examination.

Applicants' amendment and response filed April 7, 2008 have been received and entered.

Accordingly, the rejection made under 35 USC112, first paragraph (written description) as set forth in the previous Office action dated January 7, 2008 at pages 3-5 is hereby withdrawn because the applicants amended the claims to recite specific supplementary drugs.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 11 and 14-25 are again provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-36 of copending Application No. 10/070,954; over claims 1-27 of copending

Art Unit: 1614

Application No. 10/088,074; over claim 1 of copending Application No. 10/088,090; over claims 1-8 and 14 of copending Application No. 10/381,197; over claims 1-8 and 14 of copending Application No. 10/381,200; over claims 1-10, 12 and 16 of copending Application No. 10/381,655; and over claims 1-11 and 17 of copending Application No. 10/484,744. Although the conflicting claims are not identical, they are not patentably distinct from each other because of record, for reasons of record as set forth in the previous Office action dated January 7, 2008 at pages 2-3 are **MAINTAINED.**

Claims 11 and 14-25 are not allowed.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 11, 14-22 and 25 are again rejected under 35 U.S.C. 102(b) as being anticipated by EP 1,088821 A1 (AN) of PTO-1449, hereby known as Arkinstall as evidence by Bennett et al., "JNK: A new therapeutic target for diabetes", Current Opinion in Pharmacology, Vol. 3, No. 4, pp. 420-425, 2003 (AS) of PTO-1449, all of record, for reasons of record as set forth in the Office action dated January 7, 2008 at pages 5-6 as applied to claims 11-22 and 25.

Applicants remarks regarding the prior art, Arkinstall, does not teach the all the sulfonamide derivatives of formula(I) are used to treat type II diabetes, only a few are not persuasive since the applicants' claims do not recite "the specific compounds of formula (I)" that are used to treat type II diabetes that are not disclosed in Arkinstall.

The rejection made under 35 USC 102(b) is adhered to.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 23 and 24 are again rejected under 35 U.S.C. 103(a) as being unpatentable over EP 1,088,821 A1, hereby known as Arkinstall in view of Weber et al. (3,454,635), all of record, for reasons of record as set forth in the Office action dated January 7, 2008 at pages 7-8 as applied to claims 23 and 24.

Once again, Arkinstall was discussed above supra for the use of sulfonamide derivatives of formula (I) to treat metabolic disorders mediated by insulin resistance by the inhibition of JNK pathway (the JNK pathway known to cause diabetes and obesity, See Bennett et al.), and the secondary reference, Weber et al., was combined with Arkinstall to formulate the additive effect of the two individual agents well-known to treat diabetes into a single composition.

The instant rejection is based upon the well established principle of patent law that no invention resides in combining 2 or more agents of known character, where the results obtained are no more than the additive effects of the individual agents. It has not been demonstrated on the record by means of experimental data commensurate in scope with the claimed subject matter that applicants' combination produces any unobviousness or unexpected results. The mere arguments of applicants are insufficient to overcome the strong prima facie case of obviousness without the experimental data.

The rejection made under 35 USC 103 is adhered to.

Claims 23 and 24 are not allowed.